

Applicant: Gardi et al.
Filed: June 29, 2001
Application No.: 09/893,597

REMARKS

The present Amendment Response is responsive to the non-final Office Action mailed March 16, 2006. As a preliminary matter, Applicants respectfully submit that the non-final Office Action has not stated grounds for rejection for dependent Claim 17. Claims 1-25 remain pending.

By this Amendment, Applicants have amended independent Claims 1, 8, 13, 20, and 25 to recite that the qualification information does not include financial factors associated with the received billing information, historical billing information associated with the customer, or credit information associated with the customer. Applicants respectfully submit that support for the present amendment can be found at least in paragraph [0009] (referring to a technique to select customers to receive targeted supplemental information based upon information other than current or historical billing information or credit information) and paragraph [0035] (referring to “financial factors, such as billing history and credit criteria”).

Reconsideration and allowance of the application is requested.

Claim Rejections under 35 U.S.C. § 103 under Walker and Katz

In the non-final Office Action, independent Claims 1, 13, and 25 and dependent Claims 2-7 and 14-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,196,458 to Walker et al. (“Walker”) in view of U.S. Patent No. 6,055,513 to Katz et al. (“Katz”). More specifically, with respect to independent Claims 1, 13, and 25, the Office Action admits that Walker does not teach or suggest “qualification information other than the received billing information, historical billing information associated with the customer, or credit information associated with the customer.” Instead, the Office Action alleges that Katz “makes this disclosure (i.e., demographic information such as: age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers, see col. 10 lines 1-25).” (Office Action, page 3). The Office Action then makes a conclusory statement that “it would have been obvious to combine Walker and Katz to provide responsive, effective information for the upsell determination.” (Office Action, page 3).

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As described below, Claims 1-7, 13-19, and 25 are allowable over the art of record at least because (i) there is no motivation or objective teaching to combine the Walker and Katz references and (ii) even assuming, *arguendo*, that the Walker and Katz references can be combined, the proposed combination would eliminate at least one element important to both Walker and Katz, thereby rendering Walker and Katz unsatisfactory for their intended purposes.

Turning now to Walker, the reference is directed towards a billing system for printing upsell offers on a billing statement. In the billing system of Walker, a central controller 12, such as one operating for a credit card issuer, receives one or more billing items that are to be printed on the account holder's billing statement. (Col. 1, lines 64-67). The billing items represent previously purchased products. (Col. 2, lines 1-2 and 58). Based upon these previously purchased products, "the billing statement may be advantageously employed to offer and sell products complementary to previously-purchased products to the account holder." (Col. 2, lines 54-59 (emphasis added)). Applicants further submit that the system of Walker resembles the prior art billing system that has already been described in the background art of the present invention. In particular, the background art of the present invention describes a billing system where the selection of customers to receive targeted supplemental information is based upon the bill or statement itself. (Specification, para. [0005]). That is, receipt of targeted supplemental information is dependent upon purchases made and charges incurred in the last billing cycle. (Specification, para. [0005]).

Turning now to Katz, the reference is directed towards a telemarketing / electronic commerce system for the real-time offering of incentives or alternatives for purchases (e.g., an upsell) to a prospective customer at the time of a primary transaction with the prospective customer. (See Abstract and col. 12, lines 56-58). The primary transaction may be associated with a telephone or computer link contact for a sale, commercial transaction, service, repair transaction (See Abstract and Katz, col. 13, lines 64-67). In particular, in the telemarketing / electronic commerce system of Katz, an operator takes order entry data from a potential customer for the primary transaction or alternatively, the potential customer enters order data via a PC terminal for the primary transaction. (See block 10 of FIG. 1, block 140 of FIG. 4, col. 13, lines

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57-58, and col. 19, lines 24-26). The received order data of the primary transaction is compared with one or more databases for analysis to determine “upsell” data. (See block 12 of FIG. 1, col. 13, lines 60-64, block 144 of FIG. 4, and accompanying text). These databases can include credit databases, identification databases, inventory databases, and demographic databases. (Col. 9, line 65 – col. 10, lines 35). The upsell data, as determined above, is then provided or presented to the prospective customer. (See block 30 of FIG. 1, block 148 of FIG. 4, and accompanying text).

As an initial matter, Applicants respectfully submit that the conclusory statement in the Office Action does not evidence a motivation or objective teaching to combine the Walker and Katz references. As described above, the Walker and Katz references each describe systems that would not be readily combined by one of ordinary skill in the art at the time of the invention—that is, (i) a billing system for previously made purchases and (ii) a real-time telemarketing / electronic commerce system for prospective purchases. Likewise, at the time of the present invention, Applicants were not also not aware of any technique for combining a CRM (customer relationship management) system with a billing system, as indicated in the background art of the present invention. (Specification, para. [0008]). In this case, an Examiner can satisfy a burden of obviousness in light of a combination of references “only by showing some objective teaching [leading to the combination]” *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998). Therefore, combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. That is the essence of improper hindsight reasoning. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). Applicants admit that though the range of sources available as evidence of motivation can flow from the prior art references themselves, *or one of ordinary skill in the art*, the showing of motivation must be clear and particular. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). Thus, broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *See, e.g., McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

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Furthermore, Applicants submit that even assuming, *arguendo*, that the Walker and Katz references can be combined, the proposed combination would eliminate at least one element important to both Walker and Katz, thereby rendering Walker and Katz unsatisfactory for their intended purposes. More specifically, the billing system of Walker requires analyzing billing items on a billing statement for purposes of providing upsell offers, and thus, cannot determine “if the customer qualifies for presentment of supplemental information based upon qualification information, wherein the qualification information does not include financial factors associated with the received billing information...,” as recited by amended Claim 1 and similarly by amended Claims 13 and 25. Quite simply, Walker would not operate as intended if the billing items on the billing statement were not utilized for purposes of providing upsell offers because these billing items are the fundamental basis for the upsell offers. (See col. 2, lines 54-59 of Walker (stating that “the billing statement may be advantageously employed to offer and sell products complementary to previously-purchased products to the account holder”) (emphasis added)).

Likewise, Katz, which is not directed towards a billing system at all, does not cure the deficiencies of Walker in that Katz does not teach or suggest the non-use of the billing items from the billing statement in Walker for purposes of upsells. Instead, consistent with Walker requiring billing items (e.g., previous purchases) for purposes of upsells, Katz likewise requires a primary transaction (e.g., contact for a sale, commercial transaction, service, repair transaction) for purposes of offering upsells associated with the primary transaction in real-time. Indeed, the purpose of the billing items in Walker and primary transaction of Katz are essentially the same—to determine, at least in part, a complementary product or service for upsell based at least in part on the another product or service identified in the billing items in Walker or the primary transaction of Katz. (See Walker, col. 2, lines 59-60 (“The offered product is determined from previous purchases that are recorded on the billing statement, and accordingly may be a product that the account holder is more likely to purchase”) and Katz, col. 8, lines 41-43 (“identify one or more goods or services for possible proffer and upsell to customer based at least in part upon the primary transaction data provided to the system”)). Thus, neither Walker nor Katz would work

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as desired without their respective billing items or primary transactions. Therefore, the combination of Walker in view of Katz does not provide for “determining if the customer qualifies for presentment of supplemental information based upon qualification information, wherein the qualification information does not include financial factors associated with the received billing information...,” as recited by Claim 1 and similarly by Claims 13 and 25. Accordingly, independent Claims 1, 13, and 25 are allowable over Walker, Katz, and a combination thereof.

Dependent Claims 2-7, and 14-19, which depend from allowable independent Claims 1 and 13 respectively, are allowable as a matter of law, notwithstanding their independent recitation of patentable features. For example, dependent Claims 3 and 15 similarly recite “wherein the determination is based upon at least one of 1) a relationship between the customer and the biller, and 2) prior customer behavior.” Applicants respectfully submit that the “purchase of a predetermined product, or a purchase which exceeds a predefined price” as well as the “previously purchased product” of Walker cannot satisfy the above-identified features because such predetermined product, purchase, and previously purchased product of Walker are retrieved from the billing items of a billing statement. (See Walker, Abstract (“The central controller determines if the billing items, which typically specify purchases, satisfy any merchant-specified upsell offer conditions”)). Because dependent Claims 3 and 15 depend from independent Claims 1 and 13 respectively, they incorporate the additional feature of “wherein the qualification information does not include financial factors associated with the received billing information...,” which cannot be satisfied by the use of the billing items from the billing statement of Walker. Accordingly, dependent Claims 3 and 15 are allowable over Walker.

Dependent Claim 5 further recites the step of transmitting a request to a customer relationship management (CRM) system (to determine if the customer qualifies for presentment of supplemental information) and receiving a response from the CRM system (regarding whether the customer qualifies for presentment of supplemental information). Applicants respectfully submit that the central controller 12 of Walker (see FIGs. 1, 2, and 4) cannot be the CRM system of Claim 5. As illustrated in FIGs. 1, 2, and 4 of Walker, assuming *arguendo* that the central

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controller 12 is the CRM system, none of the other devices (e.g., merchant terminals, 14, 16, 18 and payment recorder 54) would transmit a request to the central controller 12 to determine if the customer qualifies for presentment of supplemental information. Likewise, none of the other devices would also receive a response (regarding whether the customer qualifies for presentment of supplemental information) from the central controller 12. Accordingly, dependent Claim 5 is still further allowable.

Dependent Claims 6 and 18 recite both a biller and a bill aggregator. Applicants respectfully submit that even assuming, *arguendo*, that the credit card account issuer (associated with the central controller 12) of Walker is the bill aggregator in Claims 6 and 18, the Office Action has not identified a biller. Indeed, referring to FIGs. 1, 2, and 4 of Walker, there is no additional entity that could be considered the biller of Claims 6 and 18. Accordingly Claims 6 and 18 are further allowable.

Claim Rejections under 35 U.S.C. § 103 under Katz and Munsil

In the non-final Office Action, independent Claims 8 and 20 and dependent Claims 9-12 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Katz in view of U.S. Patent No. 5,761,650 to Munsil et al. (“Munsil”).

Like amended independent Claims 1, 13, and 25 discussed above, amended independent Claims 8 and 20 similarly recite that the determination of whether the customer qualifies for presentment of a first or second supplemental information item is “based upon qualification information that does not include financial factors associated with the receiving billing information...” As discussed above, neither Walker, Katz, or a combination thereof satisfy the above-identified feature of Claims 8 and 20. In addition, Munsil, which the Office Action relies upon for a method of prioritizing supplemental information and printing the supplemental information on the available space according to priority, does not cure any of the deficiencies of Walker or Katz as described above. Thus, independent Claims 8 and 20 are allowable for at least similar reasons as discussed with respect to independent Claims 1, 13, and 25.

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Further, Applicants respectfully submit that the “billing information” of Claims 8 and 20 is not satisfied by the billing data of Katz, as identified in the Office Action. In particular, the “billing information” of Claims 8 and 20 provides the content for a generated bill presentation. By contrast, in the context of the telemarketing / electronic commerce system of Katz, the “billing data” does not provide content for a generated bill presentation (e.g., previously purchased products or services), but rather is synonymous with a credit card number, debit card number, other like payment information for a transaction that is to be consummated. (See Katz, col. 11, lines 59-62 (“Upon receipt of an indication that the transaction is to be consummated, the system may...automatically...provide for billing of the user”) and Claims 10, 11, 72, 102, 103 (referring to billing data as a credit card number or debit card number)). Accordingly, Applicants respectfully submit that Katz further does not teach or suggest the “billing information” of independent Claims 8 and 20. For at least the foregoing reasons, independent Claims 8 and 20 are allowable over Walker, Katz, Munsil, and a combination thereof.

Dependent Claims 9-12 and 21-24, which depend from allowable independent Claims 8 and 20 respectively, are allowable as a matter of law, notwithstanding their independent recitation of patentable features.

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CONCLUSION

The Applicants believe they have responded to each matter raised by the Examiner. Allowance of the claims is respectfully solicited. It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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